

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 3-8, 10, 12, 14-16, 18-26, 28, and 31-44 are pending in the present application, Claims 9, 11, 13, 27, and 29-30 were previously canceled without prejudice and Claims 2, 17, and 34 have been cancelled by present amendment, and Claims 1, 8, and 26 have been presently amended. No new matter was added.

In the Office Action, Claims 1-10, 12, 14-28 and 31-44 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lee et al (U.S. Patent No. 5,742,769) hereinafter referred to as Lee.

M.P.E.P. § 2131 requires for anticipation that each and every feature of the claimed invention must be shown in as complete detail as is contained in the claim. Accordingly, Applicant traverses this rejection by way of the following points which elucidate the deficiencies of Lee.

Point 1: The Office Action in the Response to Arguments section stated:

Lee disclosed informing the inquirer of the new address “via the system” because the action of Lee were performed by Lee’s system.

However, Applicant submits that Lee merely discloses at column 7, lines 45-50:

the explanatory message to the recipient indicates that the sender is trying to communicate with the recipient; the recipient should reply to the message only if the recipient wants to communicate with the sender; and if the recipient replies, the recipient’s actual email address is sent to the sender.

That is, if the recipient wishes to communicate with the sender, the recipient is required to directly reply to the sender to inform his email address.

Claim 1 define a means (e.g., inquirer reference address 39) for informing the inquirer of the new address via the system when the changer permits the disclosure of the new

address. That is, when the changer permits the disclosure of the new address, the changer is not required to directly reply to the inquirer to inform his new address. In other words, in place of the changer, the address inquiry system informs the inquirer of the new address. Further, Applicant's specification indicates at page 21, lines 8-14, that there can be obtained effects in which:

The inquirer reference address 39 is issued when the inquirer 5 has no e-mail address or does not want to use its own e-mail address even if he or she has the address, or issued for ensuring security.¹

Lee fails to suggest or disclose such effects of the present invention.

Point 2: In order to clarify the invention for the examiner's better understanding, the subject matter of Claim 2 has been incorporated into Claim 1. With regard to original Claim 2, the examiner asserted that Lee discloses a means for refusing an inquiry from the inquirer. However, as cited above, according to Lee, the recipient should reply to the message only if the recipient wants to communicate with the sender; and if the recipient replies, the recipient's actual email address is sent to the sender. That is, if the recipient wishes to refuse an inquiry from the sender, the recipient simply does not reply to the message, and the recipient's actual email address is not therefore sent to the sender. In other words, Lee fails to disclose or suggest a means for refusing an inquiry from the inquirer, which the independent claims define.

Point 3: Claim 1 presently defines a means for refusing an inquiry from the inquirer via the system when the changer refuses to permit the disclosure of the new address. One

¹ Applicant notes that the inquirer reference address 39 is one means for informing.

such example of this feature is illustrated in Applicant's specification at page 37, lines 21-22, where it is stated that:

...the screen shown in FIG. 25 is displayed in the inquirer terminal 6.

That is, the address inquiry system refuses the inquiry.

Additionally, Claim 1 defines that the means for refusing adds the inquirer to the list, and refuses an inquiry from the inquirer included in the list. One such example of this feature is illustrated in Applicant's specification at page 39, lines 12 to 15, where it is stated that:

... the inquirer 5 is registered to the inquiry refusal list 18, and hereafter inquiries from the said inquirer 5 are automatically refused until the changer 3 changes the setting.

In other words, once the changer wishes to refuse an inquiry from an inquirer, the inquirer is added to the list, i.e., his inquiry is hereafter filtered and will never reach the changer.

According to Lee, at column 7, lines 47-50:

the recipient should reply to the message only if the recipient wants to communicate with the sender; and if the recipient replies, the recipient's actual email address is sent to the sender.

That is, according to Lee, even if the recipient wishes to refuse an inquiry from the sender, the sender is not added to a list. Accordingly, even though the recipient wishes to hereafter refuse inquiries from the sender, since he is not registered to the list of Lee, his inquiries may repeatedly reach the recipient. That is, inquiries from the sender are not automatically refused, and Lee cannot obtain the filtering effect of the claimed features.

Point 4: The examiner asserted that Lee discloses at column 5, lines 42-65; column 6, lines 1-7; and column 6, lines 48-67, that the data base includes a list of specific inquirers who are refused inquiries about the new address. However, the "list" as described in those lines is "a list of searchable 'types' or interests that currently exist so that the user can select from one or more existing types." See column 5, lines 56-58.

To this list, the user of Lee enters his/her profile. Hence, the list according to Lee is different from the list defined in the independent claims, to which information of an inquirer is entered. The examiner also contends that Lee discloses a means for refusing an inquiry from the inquirer included in the list. However, since the list of Lee does not include an inquirer, this assertion is in error.

Summary: The above discussion makes clear the deficiencies of Lee to show each and every feature of the claimed invention in as complete detail as is contained in the claim. Independent Claims 8, 23, and 24 define similarly distinguishing features from Lee. For example, a means for refusing an inquiry of Claim 1 is similar to an address disclosure refusing means of Claim 8. The list of Claim 1 is similar to the disclosing condition registering means of Claim 8. The feature “refuses an inquiry from the inquirer included in the list” of Claim 1 is similar to the feature “an inquirer to whom the address is disclosed or not disclosed” of Claim 8.


Similarly, independent Claim 26 defines similarly distinguishing features from Lee. For example, a means for refusing an inquiry of Claim 1 is similar to an address disclosure refusing step of Claim 26. The “list” of Claim 1 is similar to the disclosing condition registering means of Claim 26. The feature “refuses an inquiry from the inquirer included in the list” of Claim 1 is similar to the “registering the inquirer in the disclosing condition as registering the inquirer in the disclosing condition as an inquirer to whom the address is disclosed or not disclosed” of Claim 26.

Hence, for the failure of Lee to show the above noted features, independent Claims 1, 8, 23, 24, and 26 and the claims dependent therefrom are believed to patentably define over Lee et al.

Conclusion: In light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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